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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,396	04/28/2000	HIDEMI HENMI	2000-0545 A	5651

7590 10/22/2004

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WASHINGTON, DC 20006

EXAMINER

DEMICCO, MATTHEW R

ART UNIT PAPER NUMBER

2611

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/530,396

Applicant(s)

HENMI, HIDEKI

Examiner

Matthew R Demicco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed 6/16/04. Claims 1-24 are pending. Claims 1, 4, 10-12, 16 and 19 are amended.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 10 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Applicant has attempted to overcome the prior 35 U.S.C. 102(b) rejection of Young by changing the claimed "updated" data to "revised" data (See the 35 U.S.C. 112 first paragraph rejection below). Webster's Revised Unabridged Dictionary (1998) defines "revised" as "To review, alter, and amend; as, to revise statutes; to revise an agreement; to revise a dictionary." However, alteration or amendment does not preclude replacement of the data as a whole. The broadest reasonable interpretation of revised data as it pertains to recorded video programming could be a different episode of the same series, or a complete substitution of data altogether (i.e.: a different program). Further, recording of, for instance, the 6 o'clock news and then the 11 o'clock news may be considered a revision since much of the content remains the same. The new limitation of previously stored data being replaced by newly received revised data is addressed in the 35 U.S.C. 103(a) rejections below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 10 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding these claims, Applicant has introduced the concept of "revised" data, which is not disclosed in the specification or drawings. Throughout the application, data is referred to as "updated" (e.g.: Page 20, Lines 5-10). The definition of updated and the definition of revised are not synonymous, therefore there is insufficient support in the disclosure for the claimed revised data.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-24 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,706,121 to Young in view of International PCT WO 92/22983 to Browne et al.

Regarding Claim 1, Young discloses a storage-type data receiver (See Figure 3) for receiving (See Tuner 132) and storing (See VCR 150) TV programming (Col. 7,

Lines 66-68) and TV scheduling information (Col. 6, Lines 60-64). The TV programming reads on data being updated at irregular intervals. The scheduling information reads on next-update information indicating when the data will be next revised, both the data and next-update information being distributed by a data source. Young further discloses a reception means for receiving the data and next-update information (132) and a storage means for storing the data (111). Young further discloses the use of the scheduling data to automatically trigger the storage of a program for unattended recording (Col. 12, Lines 14-24). When a recording event is scheduled, a test is performed to see if the system clock is within the scheduled time (Col. 20, Lines 40-43). It is inherent that there must be a signal or indication from the comparator instructing the recording device to become active. This reads on the claimed data update detection means for comparing a current time and a next-update time indicated by the next-update information so as to generate a data update time indication signal indicating whether or not it is time to revise the data. The data being revised is the video program to be recorded. Further disclosed is a data storage control means for controlling storage of the data in the storage means based on the data update time indication signal (Col. 20, Lines 54-64). What is not disclosed, however, is that the previously stored data in the storage means is replaced by the newly received revised data. Browne discloses a video recording system (See Figures 1 and 6) for receiving and recording transmission signals (Page 6, Lines 1-4) wherein programs to be recorded are stored in a finite capacity storage section and are automatically erased to make room for newly recorded programs (Page 19, Lines 6-18). Browne is evidence that ordinary workers in the art would appreciate the ability to erase an old program to make

room for a new program in a video recording system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Young with the replacement of data of Browne in order to optimize available space and prevent missing of recorded programs due to lack of space on a finite sized recording medium. This reads on the claimed replacing previously stored data with newly received revised data.

Regarding Claim 2, Young in view of Browne disclose a system as stated above in Claim 1. Young further discloses a system wherein the video recorder is controlled to store the received data when the scheduled time coincides with the current time as stated above. This reads on the claimed data storage control means controlling the storage means to store the received data when the current time coincides with the next-update time.

Regarding Claim 3, Young in view of Browne disclose a system as stated above in Claim 1. Young further discloses a system wherein the reception means comprises a tuner means (132) for arbitrarily selecting a signal of a broadcast channel among plural signals of broadcast channels (Col. 7, Lines 66-68) and a tuner control means for controlling channel selection (Col. 8, Lines 48-66) by the tuner means based on the data update time indication signal (Col. 8, Lines 35-40).

Regarding Claim 4, Young in view of Browne disclose a system as stated above in Claim 3. Young further discloses a system wherein the tuner control means controls the tuner means in such a manner so as to enable the tuner means to tune itself with the

arbitrarily selected channel when the current time coincides with the next-update time (Col. 4, Lines 48-52 and Col. 8, Lines 23-40).

Regarding Claim 5, Young in view of Browne disclose a system as stated above in Claim 1. Young further discloses a system further comprising a power supply control means for controlling power supply to the reception means based on the data update time indication signal (Cols. 8-9, Lines 62-4).

Regarding Claim 6, Young in view of Browne disclose a system as stated above in Claim 5. Young further discloses a system wherein the power supply control means supplies power to the reception means only when the current time coincides with the next-update time (Col. 20, Lines 40-64).

Regarding Claim 7, Young in view of Browne disclose a system as stated above in Claim 5. It is inherent that the power supply control means supplies power to the data update detection means regardless of the data update time indication signal. If this were not the case, the control logic would not be active and would never know when to turn on the recorder for recording.

Regarding Claim 8, Young in view of Browne disclose a system as stated above in Claim 3. Young further discloses the selection of themes or particular programs for unattended recording (Col. 12, Lines 14-24). These programs will be recorded based on their identification without user intervention regardless of what time they are broadcast. This reads on the claimed storage data identification information means for generating identification information for specifying the data to be stored, wherein, based on the

identification information, the tuner control means tunes the channel of the tuner means to a broadcast channel through which the data to be stored is distributed.

Regarding Claim 9, Young in view of Browne disclose a system as stated above in Claim 8. In such a system that may automatically record data based on pre-selected parameters such as theme, there must inherently be a data extraction means for extracting the specified data to be stored from the received data based on the identification information.

Regarding Claims 10-12, see Claims 1-3 above.

Regarding Claims 13-15, see Claim 10 above. It is inherent in such a computer-based system (See Figure 3) that there must be a computer program running thereon to carry out the methods as stated above.

Regarding Claims 16-24, see Claims 1-9 above.

### ***Conclusion***

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



mrd

October 13, 2004

  
CHRIS GRANT  
PRIMARY EXAMINER